

REMARKS

Applicant hereby traverses the objections and rejections of the Final Office Action dated December 16, 2003, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Claim 5 has been canceled without prejudice. Claims 1-4 and 6-21 are pending in this application.

Objections to the Drawings

The Examiner has objected to the drawings, as not depicting every feature of the claimed invention, specifically the time-delayed shut off switch of claim 9 is not shown in the Figures. In response, Applicant has amended Figure 2 to include shut off switch 99. Applicant has also amended the specification at page 11, line 20 to include the reference label 99 in a time delayed shut off switch discussion. No new matter has been entered with these amendments.

The Examiner has also objected to Figure 1 as not having any distinction between the elements 10 and 12. In response, Applicant has amended Figure 1 to show a distinction between elements 10 and 12. As discussed in the specification, element 10 is operating mode indicator apparatus and element 12 is the mouse. No new matter has been entered with these amendments.

As each identified instance of informality has been corrected with a corresponding proposed amendment, Applicant believes that the objections to the drawings have been overcome, and that these objections should be withdrawn.

Objections to the Claims

Claims 15 and 16 are objected to for informalities listed on pages 5-6 of the Office Action, specifically, the word "comprising" is improper because the computer pointing device cannot comprise a larger element like a system. While this interpretation is arguable, in an effort to amicably advance prosecution, Applicant has amended claim 15 to use the word "wherein". Claim 15 has been amended only for the purpose of resolving the cited informality, and not for the purpose of narrowing its scope in the face of prior art. No new matter has been entered.

Applicant has not amended claim 16, as the control system may reside in the computer pointing device, e.g. see column 5, line 10, column 9, line 34, and/or column 10, line 1.

As each identified instance of informality has been addressed with a corresponding amendment or argument, Applicant respectfully requests the withdrawal of the objection of record.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 8-9 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the words “the operating mode indicator apparatus” in these claims lacks antecedent basis. In response, Applicant has amended claims 8 and 9 to recite “first illumination apparatus” and “second illumination apparatus”. These claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered. As each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment, Applicant respectfully requests the rejection of claims 8-9 under 35 U.S.C. §112, second paragraph be withdrawn.

Rejection under 35 U.S.C. § 103(a)

Claims 1-6, 8-9, 15-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over McDonough et al. ('873, hereinafter McDonough).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicant asserts that the rejection does not satisfy at least the third criteria.

Claim 1 defines a computer-pointing device wherein said first illumination apparatus generating light when the computer-pointing device is in a standby mode, and said second illumination apparatus generating light when the computer-pointing device is in an input

operating mode. McDonough does not teach these limitations. Instead, McDonough teaches having its lights indicate a status of the personal computer to which it is tethered, see column 7, line 60 to column 8, line 65. Thus, McDonough does not teach the all of the claimed limitations. Therefore, the Applicant respectfully asserts that at least for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 18 defines a method comprising illuminating said first illumination apparatus if it is determined that the computer-pointing device is in the standby mode, and illuminating said second illumination apparatus if it is determined that the computer-pointing device is in the input operating mode. McDonough does not teach these limitations. Instead, McDonough teaches having its lights indicate a status of the personal computer to which it is tethered, see column 7, line 60 to column 8, line 65. Thus, McDonough does not teach the all of the claimed limitations. Therefore, the Applicant respectfully asserts that at least for the above reasons claim 18 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 20 defines a computer-pointing device comprising means for providing for a user a first visual indication that the computer-pointing device is in a standby mode; and means for providing the user a second visual indication that the computer-pointing device is in an input operating mode. McDonough does not teach these limitations. Instead, McDonough teaches having its lights indicate a status of the personal computer to which it is tethered, see column 7, line 60 to column 8, line 65. Thus, McDonough does not teach the all of the claimed limitations. Therefore, the Applicant respectfully asserts that at least for the above reasons claim 20 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 21 defines a computer-pointing device comprising a first illumination apparatus, said first illumination apparatus generating light when the computer-pointing device is in a standby mode, and a second illumination apparatus, said second illumination apparatus generating light when the computer-pointing device is in an input operating mode. McDonough does not teach these limitations. Instead, McDonough teaches having its lights indicate a status of the personal computer to which it is tethered, see column 7, line 60 to column 8, line 65. Thus, McDonough does not teach the all of the claimed limitations. Therefore, the Applicant respectfully asserts that at least for the above reasons claim 20 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-4, 6, 8-9, 15-17, and 19 depend directly from base claims 1 and 18, respectively, and thus inherit all limitations of their respective base claim. Claims 6, 15, 16, and 19 have been amended to correspond with amendments made to claims 1 and 18 respectively. Each of claims 2-4, 6, 8-9, 15-17, and 19 sets forth features and limitations not recited by McDonough. Thus, the Applicant respectfully asserts that at least for the above reasons claims 2-4, 6, 8-9, 15-17, and 19 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection under 35 U.S.C. § 103(a)

Claims 7, 10-11, and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonough in view of Hinckley et al. ('830, hereinafter Hinckley).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicant asserts that the rejection does not satisfy at least the third criteria.

Base claim 1 is defined as described above. McDonough does not disclose these limitations, as discussed above. Hinckley is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references set forth in this rejection does not teach all elements of the claimed invention.

Claims 7, 10-11, and 13-14 depend from base claim 1, and thus inherit all limitations of claim 1. Each of claims 7, 10-11, and 13-14 sets forth features and limitations not recited by the combination of McDonough and Hinckley. Thus, the Applicant respectfully asserts that for the above reasons claims 7, 10-11, and 13-14 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection under 35 U.S.C. § 103(a)

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonough in view of Hinckley in further view of Dai et al. ('322, hereinafter Dai).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicant asserts that the rejection does not satisfy at least the third criteria.

Base claim 1 is defined as described above. McDonough does not disclose these limitations, as discussed above. Hinckley is not relied upon in the Office Action as disclosing these limitations. Dai is also not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references set forth in this rejection does not teach all elements of the claimed invention.

Claim 12 depend from base claim 1, and thus inherit all limitations of claim 1. Claim 12 sets forth features and limitations not recited by the combination of McDonough, Hinckley, and Dai. Thus, the Applicant respectfully asserts that at least for the above reasons claim 12 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Application No.: 09/900,211

Docket No.: 10003357-1

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003357-1, from which the undersigned is authorized to draw.

Dated: March 11, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No EV255076260US, in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: March 11, 2004

Signature: 

Carrie Wilson

Respectfully submitted,

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Attachments: Drawings